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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/819,336 | 19,336 03/28/2001 Daniel F. Graves | | P96040US1A/FIR 2 0020 | 4242 |
| 7. | 590 11/12/2002 | | | |
| Chief Intellectual Property Counsel Bridgestone/Firestone, Inc. 1200 Firestone Parkway | | | EXAMINER | |
| | | | LU, C CAIXIA | |
| Akron, OH 44 | 1317-0001 | | ART UNIT PAPER NUMBER | |
| | | | 1713 | 4 |
| | | | DATE MAILED: 11/12/2002 | |
| | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | mr-4 | | | |
|---|--|--|---|--|--|--|
| | | Application No. | Applicant(s) | | | |
| Office Action Summary | | 09/819,336 | GRAVES ET AL. | | | |
| | | Examiner | Art Unit | | | |
| | | Caixia Lu | 1713 | | | |
| The MAILING DATE of this of Period for Reply | communication app | ears on the cover sheet with the | orrespondence addr ss | | | |
| | MMUNICATION. provisions of 37 CFR 1.13 If this communication. nan thirty (30) days, a reply asximum statutory period w od for reply will, by statute, the months after the mailing | 36(a). In no event, however, may a reply be ting within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE | nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133). | | | |
| 1) Responsive to communicat | ion(s) filed on | · | | | | |
| 2a)☐ This action is FINAL. | 2b) ☐ Th | is action is non-final. | | | | |
| 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | | | | |
| Disposition of Claims | n in the englishing | | | | | |
| 4) ⊠ Claim(s) <u>1-20</u> is/are pending | - | | | | | |
| 4a) Of the above claim(s) | | wil from consideration. | | | | |
| | Claim(s) is/are allowed. | | | | | |
| | Claim(s) is/are rejected. | | | | | |
| • | 7) Claim(s) is/are objected to. | | | | | |
| 8) Claim(s) <u>1-20</u> are subject to restriction and/or election requirement. Application Papers | | | | | | |
| 9)☐ The specification is objected | to by the Examine | r. | | | | |
| 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. | | | | | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | | | | |
| 11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner. | | | | | | |
| If approved, corrected drawings are required in reply to this Office action. | | | | | | |
| 12) The oath or declaration is objected to by the Examiner. | | | | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | | | | |
| 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | | | | | |
| a) ☐ All b) ☐ Some * c) ☐ None of: | | | | | | |
| 1. Certified copies of the priority documents have been received. | | | | | | |
| 2. Certified copies of the priority documents have been received in Application No | | | | | | |
| 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | | | | | |
| 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). | | | | | | |
| a) ☐ The translation of the foreign language provisional application has been received. 15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | | | | |
| Attachment(s) | | | | | | |
| 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing 3) Information Disclosure Statement(s) (PTO | | 5) Notice of Informal | y (PTO-413) Paper No(s) Patent Application (PTO-152) | | | |
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DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-10, drawn to a process for the preparation of a carboxylate terminated polymer, classified in class 526, subclass 173.
 - II. Claims 11-18, drawn to a carboxylate terminated polymer, classified in class 526, subclass 335.
 - III. Claims 19 and 20, drawn to a rubber-modified styrene polymer product, classified in class 525, subclass 191.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be prepared by a materially different process wherein a different anionic initiator such as an organosodium initiator is used.
- Inventions II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the



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instant case, the intermediate product is deemed to be useful as a elastomer material by itself and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

- 4. Inventions I andIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are the process of making a carboxylate terminated polymer and a rubber-modified styrene polymer product, the process cannot be used to prepared the rubber-modified styrene polymer product.
- 5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- Because these inventions are distinct for the reasons given above and the search required for one of the groups is not required for the rest of the group, restriction for examination purposes as indicated is proper.



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- 7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
- 8. A telephone call was made to Attorney Scott McCollister on September 19, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu whose telephone number is (703) 306-3434. The examiner can normally be reached on 9:00 a.m. to 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1193.

Caixia Lu, Ph. D.

Examiner

November 8, 2002